

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. 10/590,264
Applicant: Paul A. Kohl, et al.
Title: MICROSTRUCTURE AND METHODS OF
FABRICATION THEREOF
Filed: August 18, 2006
Docket No. 36157/8 (formerly 36157/1.9)

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

SECOND RENEWED REQUEST UNDER 37 C.F.R. 1.497(d)

TO THE COMMISSIONER FOR PATENTS

This paper is submitted in response to the Commissioner of Patents' DECISION ON RENEWED REQUEST UNDER 37 CFR 1.497(d). The request sought to delete an inventor from the application.

There are four requirements under 37 CFR 1.497(d):

- (1) A statement from each . . . person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention.
- (2) The processing fee set forth in §1.17(i)
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee; and
- (4) Any new oath or declaration required by (f) of this section

The decision on the original Request states that Items (1) and (2) were satisfied and that Item (4) does not apply to the present application. The Renewed Request was submitted with accompanying documents seeking to satisfy Item (3). The accompanying documents included an

executed ASSIGNMENT designating Georgia Tech Research Corporation as assignee (hereafter, the "Assignee") and a statement providing the written consent of the Assignee.

The Decision dismisses the Renewed Request without prejudice on the grounds that Item (3) still is not satisfied. Specifically, the previously submitted statement of the Assignee granting consent to the requested removal of an inventor did not satisfy the requirements of 37 C.F.R. 1.497(d)(3). The statement did not state that the documentary evidence of chain of title was submitted concurrently. Moreover, the statement did not expressly state that the person signing the statement was authorized to act on behalf of the Assignee.

Applicant hereby renews, a second time, the request under 37 C.F.R. 1.497(d) for the above-identified application. As explained in the original request and the renewed request, an inventorship error occurred in the above-identified application without deceptive intention on the part of the inventors or the Assignee. Therefore, correction of inventorship is requested by deleting the following inventor: **Justin Tullis**

Enclosed is a statement that the Assignee consents to deleting the above named inventor pursuant to 37 C.F.R. §1.497(d) (hereafter, the "Statement"). The Statement indicates the reel and frame of the documentary evidence of the chain of title from the original owner to the Assignee as recorded in the assignment records of the Office. The Statement also includes an express statement that the person signing the statement is authorized to act on behalf of the Assignee. Thus, the Statement should satisfy the final requirement for the request under 37 C.F.R. 1.497(d).

The application is now believed to be complete and ready for examination. If the Office of PCT Legal Administration has further questions regarding this issue, please contact the undersigned.

Respectfully submitted,

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